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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/528,644	03/20/2000	Lars Thim	3951.224-US	5698

7590 08/11/2003

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EXAMINER
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ROMEO, DAVID S

ART UNIT	PAPER NUMBER
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1647

DATE MAILED: 08/11/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/528,644

Applicant(s)

THIM ET AL.

Examiner

David S Romeo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 27-38 and 40-65 is/are pending in the application.
- 4a) Of the above claim(s) 34, 35, 37 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 27-38 and 40-65 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

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**DETAILED ACTION**

The amendment filed May 19, 2003 (Paper No. 15) has been entered. Claims 27-38, 40-65 are pending. Claims 34, 35, 37, 38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or

5 linking claim. Election was made **without** traverse in Paper No. 5.

***Election/Restrictions***

This application contains claims directed to the following patentably distinct species of the claimed invention: a homolog of SEQ ID NO: 1 wherein the homolog has 39 amino acids in the first trefoil domain; a homolog of SEQ ID NO: 1 wherein the homolog has 38 amino acids in the second trefoil domain; a homolog of SEQ ID NO: 1 wherein the homolog is identical to SEQ ID NO: 1 except for two amino acid substitutions; a homolog of SEQ ID NO: 1 wherein the homolog is identical to SEQ ID NO: 1 except for a deletion at either end of SEQ ID NO: 1; a homolog of SEQ ID NO: 1 wherein the homolog is identical to SEQ ID NO: 1 except for an addition to either end of SEQ ID NO: 1.

15 Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 27, 40-65 are generic.

If the species "a homolog of SEQ ID NO: 1 wherein the homolog has 39 amino acids in the first trefoil domain" is elected Applicant is required under 35 U.S.C. 121 to elect a single disclosed species from the 39 amino acids in the first trefoil domain are amino acids 8-46 of SEQ ID NO: 1 except for two amino acid substitutions; the 39 amino acids in the first trefoil domain

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are amino acids 8-46 of SEQ ID NO: 1; the 38 amino acids in the second trefoil domain are 58-95 of SEQ ID NO: 1 except for two amino acid substitutions.

If the species “a homolog of SEQ ID NO: 1 wherein the homolog has 39 amino acids in the first trefoil domain” is elected in combination with the species the 38 amino acids in the

5 second trefoil domain are 58-95 of SEQ ID NO: 1 except for two amino acid substitutions

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species from the 39 amino acids in the first trefoil domain are amino acids 8-46 of SEQ ID NO: 1; the 38 amino acids in the second trefoil domain are amino acids 58-95 of SEQ ID NO: 1; the 38 amino acids in the second trefoil domain are amino acids 58-95 of SEQ ID NO: 1 and the 39 amino acids in the first trefoil  
10 domain are amino acids 8-46 of SEQ ID NO: 1.

If the species “a homolog of SEQ ID NO: 1 wherein the homolog has 38 amino acids in the second trefoil domain” Applicant is required under 35 U.S.C. 121 to elect a single disclosed species from the 38 amino acids are identical to amino acids 58-95 of SEQ ID NO: 1 except for two amino acid substitutions; the 38 amino acids are identical to amino acids 58-95 of SEQ ID  
15 NO: 1.

If the species a homolog of SEQ ID NO: 1 wherein the homolog is identical to SEQ ID NO: 1 except for two amino acid substitutions” is elected Applicant is required under 35 U.S.C. 121 to elect a single disclosed species from the amino acid substitutions are in the first trefoil domain; the amino acid substitutions are in the second trefoil domain.

20 Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable

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thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

ANY INQUIRY CONCERNING THIS COMMUNICATION OR EARLIER COMMUNICATIONS FROM THE EXAMINER SHOULD BE DIRECTED TO DAVID S. ROMEO WHOSE TELEPHONE NUMBER IS (703) 305-4050. THE EXAMINER CAN NORMALLY BE REACHED ON MONDAY THROUGH FRIDAY FROM 7:30 A.M. TO 4:00 P.M.

IF ATTEMPTS TO REACH THE EXAMINER BY TELEPHONE ARE UNSUCCESSFUL, THE EXAMINER'S SUPERVISOR, GARY KUNZ, CAN BE REACHED ON (703) 308-4623.

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IF SUBMITTING OFFICIAL CORRESPONDENCE BY FAX, APPLICANTS ARE ENCOURAGED TO SUBMIT OFFICIAL CORRESPONDENCE TO THE FOLLOWING TC 1600 BEFORE AND AFTER FINAL RIGHTFAX NUMBERS:

BEFORE FINAL (703) 872-9306

AFTER FINAL (703) 872-9307

IN ADDITION TO THE OFFICIAL RIGHTFAX NUMBERS ABOVE, THE TC 1600 FAX CENTER HAS THE FOLLOWING OFFICIAL FAX NUMBERS: (703) 305-3592, (703) 308-4242 AND (703) 305-3014.

CUSTOMERS ARE ALSO ADVISED TO USE CERTIFICATE OF FACSIMILE PROCEDURES WHEN SUBMITTING A REPLY TO A NON-FINAL OR FINAL OFFICE ACTION BY FACSIMILE (SEE 37 CFR 1.6 AND 1.8).

FAXED DRAFT OR INFORMAL COMMUNICATIONS SHOULD BE DIRECTED TO THE EXAMINER AT (703) 308-0294.

ANY INQUIRY OF A GENERAL NATURE OR RELATING TO THE STATUS OF THIS APPLICATION OR PROCEEDING SHOULD BE DIRECTED TO THE GROUP RECEPTIONIST WHOSE TELEPHONE NUMBER IS (703) 308-0196.



DAVID ROMEO  
PRIMARY EXAMINER  
ART UNIT 1647

DSR  
AUGUST 9, 2003